

REMARKS

This application pertains to a novel adhesive tape, having a pressure-sensitive adhesive which comprises unmasticated natural rubber and a thermally labile crosslinker system.

Claims 1, 2, 4-9 and 13-16 are pending.

The claims are being amended to more clearly recite that the natural rubber is unmasticated. Support can be found at page 20, line 22 of the specification.

In the cover sheet of the office action, the Examiner indicates that Applicants' priority document has not been received. However, Applicants' post card receipt and the cover sheet of the office action of 12/13/2001, copies of which are annexed hereto, both indicate that the priority document has, in fact, been received. Clarification is respectfully requested.

Turning now to the substance of the office action, claims 1, 2, 4, 8 and 13-16 stand rejected under 35 U.S.C. 103(a) as obvious over Nitto Denko Corp (JP 07-126590) in view of Yarusso (US 5,866,249). The Examiner seems to believe that if one were to combine the antioxidants, fillers and plasticizers of the Yarusso reference with the adhesives of Nitto Denko, somehow Applicants' invention would be arrived at.

The Examiner overlooks the fact that Nitto Denko's natural rubber is masticated. See paragraphs [0009] and [0021]. Applicants' natural rubber is unmasticated. An adhesive comprising unmasticated natural rubber is very different than an adhesive comprising

masticated natural rubber (specification, page 2, lines 9-33). Applicants' adhesive composition is very different than anything that can be found in the Nitto Denko reference, and the differences are far greater than just the amounts of various additives. The use of Yarusso's additives will not therefore in any way compensate for the differences.

Accordingly, Applicants' claims cannot be seen as obvious over any combination of Nitto Denko and Yarusso, and the rejection of claims 1,2, 4, 8 and 13-16 under 35 U.S.C. 103(a) as obvious over Nitto Denko Corp (JP 07-126590) in view of Yarusso (US 5,866,249) should be withdrawn.

Claim 7 stands rejected under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of The Wiggins Teape Group Limited. The Examiner relies on The Wiggins Teape Group Limited for a primer layer. No primer layer could ever overcome the differences between Applicants' invention and anything that could be derived from the Nitto Denko/Yarusso combination of references, as discussed above. The rejection of claim 7 under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of The Wiggins Teape Group Limited should accordingly now be withdrawn.

Claim 9 stands rejected under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of Müssig et al. The Examiner relies on Müssig et al. for corona or flame treatment. Such treatment cannot possibly overcome the differences between Applicants' invention and anything that could be derived from the Nitto Denko/Yarusso combination of references, as discussed above. The rejection of claim 9 under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above,

and in further view of Müssig et al. should therefore be withdrawn.

Claim 6 stands rejected under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of Hitachi Chem. The Examiner relies on Hitachi Chem for the addition of acrylic monomers and the use of irradiation. This will not in any way overcome the differences between Applicants' invention and anything that could be derived from the Nitto Denko/Yarusso combination of references, as pointed out above however. The rejection of claim 6 under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of Hitachi Chem should accordingly be withdrawn.

Finally, claim 5 stands rejected under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of Hitachi Chem and Yamamoto et al. The differences between the Nitto Denko/Yarusso/Hitachi Chem combination of references is discussed above. The Examiner relies on Yamamoto for a teaching of photoinitiators in acrylic curing systems. This will not in any way compensate for the basic deficiencies of the Denko/Yarusso/Hitachi Chem combination of references, as discussed above, however. Accordingly, the rejection of claim 5 under 35 U.S.C. 103(a) as obvious over Nitto Denko in view of Yarusso as applied above, and in further view of Hitachi Chem and Yamamoto et al. should now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1, 2, 4-9 and 13-16 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME


If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS, McLAUGHLIN & MARCUS, P.A.

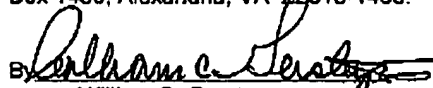
By 
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WCG:tmo

Enclosures-Copy of 12/13/2001 Office Action indicating priority document received (1 sheet)
Copy of Return Receipt Postcard indicating receipt of priority document (1 sheet)
Petition for Extension of Time (1 sheet)

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I hereby certify that this correspondence is being transmitted via facsimile no. (703) 872-9306 to the United States Patent and Trademark Office, addressed to: Mail Stop Amendment, Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By 
William C. Gerstenzang

Date May 9, 2005

Office Action Summary

Application No.

09/841,014

Applicant(s)

WENNINGER ET AL.

Examiner

Travis B Ribar

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 10, 15 and 16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

CASE # BEIERSDORF 634-WCG

Serial No. To Be Assigned

DATE MAILED:

August 17, 2000

. DATE DUE:

August 18, 2000

The stamp of the Patent Office hereon may be taken as
acknowledgement of receipt, on the date stamped, of the
following:

VIA EXPRESS MAIL, Label No. EH976287555US:

- Utility Patent Application Transmittal (1 page)
- Fee Transmittal (1 page, in duplicate)
- Preliminary Amendment (5 pages)
- Original specification, including Description (pp. 1-35);
- Patent Claims (p. 36-37); Abstract (unnumbered)
- Recordation Form Cover Sheet (2 pages, in duplicate)
- Executed Assignment (1 page)
- Executed Combination Declaration/Power of Attorney (3 pages)
- Priority Document No. 199 39 07612
- Information Disclosure Statement (2 pages)
- Form PTO-1449 (1 page), citing and attaching five (5) references
- Appendix (1 page)

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